

Attorney Docket No. 108298529
Disclosure No. 99-1289

REMARKS

At the time the present Office Action was mailed, claims 1-34 were pending in this application. Claims 1, 3, 9, 13, 18, 23 and 27-34 have been cancelled from the application in this response, without prejudice to pursuing these claims in a continuation, divisional, continuation-in-part, or other application. Claims 2, 4-7, 10-12, 19, 21, 22 and 26 have been amended, and new claims 73-83 have been added in this response. Accordingly, claims 2, 4-8, 10-12, 14-17, 19-22, 24-26 and 73-83 are now pending in this application.

In the Office Action mailed August 27, 2003, claims 1-7, 9-13, 18, 19, 21-23 and 26 were rejected. More specifically, the status of the application in light of this Office Action is as follows:

- (A) Claims 1, 3-5, 7, 9, 12, 13, 18, 22, 23 and 26 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,984,035 to Nalle ("Nalle");
- (B) Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nalle in view of U.S. Patent No. 3,338,458 to Hultgren ("Hultgren"); and
- (C) Claims 6, 10, 11, 19 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nalle.

The undersigned attorney wishes to thank the Examiner for engaging in telephone conference on October 2, 2003. During that telephone conference, the present Office Action, the Nalle and Hultgren references, the pending claims, and several proposed claim amendments were discussed. The Examiner agreed that new claim 73 is patentable over Nalle. The following remarks summarize and further expand upon the points discussed during the October 2 telephone conference.

A. Response to the Section 102(b) Rejection over Nalle

Claims 1, 3-5, 7, 9, 12, 13, 18, 22, 23 and 26 were rejected under 35 U.S.C. § 102(b) as being anticipated by Nalle. Claims 1, 3, 9, 13, 18 and 23 have been cancelled in this response and therefore the rejection of these claims is now moot.

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Claims 4, 5, 7 and 12 have been amended to depend from new claim 74. Accordingly, the Section 102(b) rejection of claims 4, 5, 7 and 12 should be withdrawn for the reasons discussed below with reference to new claim 74 and for the additional features of these claims. Claims 22 and 26 have been amended to depend from new claim 73. Accordingly, the Section 102(b) rejection of claims 22 and 26 should be withdrawn for the reasons discussed below with reference to new claim 73 and for the additional features of these claims.

B. Response to the Section 103(a) Rejection over Nalle and Hultgren

Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nalle in view of Hultgren. Claim 2 has been amended to depend from new claim 74. Accordingly, the Section 103(a) rejection of claim 2 should be withdrawn for the reasons discussed below with reference to new claim 74. Furthermore, Hultgren fails to cure the below-noted deficiencies of Nalle as references supporting a *prima facie* case of obviousness under Section 103(a). For example, Hultgren discloses a lipstick device having a colored inner sleeve, a transparent outer sleeve, and indicia printed on the inner sleeve that is visible through the transparent outer sleeve. Hultgren does not provide motivation to add to Nalle's tumbler a background material that is "configured so that at least approximately the entire first surface of the background material in the base portion and in the first region of the wall portion is visible through the second region of the wall portion from the exterior region," as recited by new claim 74. Therefore, the Section 103(a) rejection of claim 2 should be withdrawn.

C. Response to the Section 103(a) Rejection over Nalle

Claims 6, 10, 11, 19 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nalle. Claims 6, 10 and 11 have been amended to depend from new claim 74. Accordingly, the Section 103(a) rejection of claims 6, 10 and 11 should be withdrawn for the reasons discussed below with reference to claim 74 and for the additional features of these claims. Claims 19 and 21 have been amended to depend from new claim 73. Accordingly, the Section 103(a) rejection of claims 19 and 21

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should be withdrawn for the reasons discussed below with reference to claim 73 and for the additional features of these claims.

D. New Claims 73-83 Are Patentable Over Nalle

During the October 2 telephone conference, the Examiner agreed that new claim 73 is patentable over Nalle. New claims 74-83 are also patentable over Nalle for the reasons described below.

1. New Claim 74 Is Directed to a Vessel Including a Background Material Configured so that the Entire Surface of the Background Material in a Base Portion and in a First Region of a Wall Portion Is Visible Through a Second Region of the Wall Portion from an Exterior Region

Claim 74 is directed to a vessel for observing a chemical substance. The vessel includes a base portion, an optically transmissive wall portion projecting away from the base portion, and a background material. The base portion has an outer surface and an inner surface. The optically transmissive wall portion has an inner surface, an outer surface, a first region, and a second region opposite the first region. The outer surfaces of the base and wall portions define an exterior region, and the inner surfaces of the base and wall portions define an interior region. The interior region is configured to contain the chemical substance and has an opening configured to removably receive the chemical substance. The background material has a first surface facing toward the interior region and a second surface facing away from the first surface. The background material is positioned between the inner and outer surfaces of the base portion and the wall portion. The background material is configured so that at least approximately the entire first surface of the background material in the base portion and in the first region of the wall portion is visible through the second region of the wall portion from the exterior region. Accordingly, the background material allows a practitioner to view the chemical substance against the background material without having to separately support and move an adjacent piece of background material, such as a sheet of paper or a paper towel.

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2. Nalle Discloses an Ornamental Double-Walled Tumbler

Nalle discloses a tumbler having an outer shell, an inner shell, an ornamental sheet interposed between the side walls of the outer and inner shells, and a paper disk interposed between the base portions of the outer and inner shells. The tumbler also has a flared upper edge that curves radially outward as it projects away from the base. The ornamental sheet extends from the flared edge to the base all the way around the tumbler. The ornamental sheet enhances the heat insulating properties of the tumbler "so that a cold drink stays cold longer, without moisture or dew dripping from its outer walls, while a hot drink stays hot longer, and can be held in the hand without discomfort." (Nalle, col. 2, ll. 55-58.)

3. New Claim 74 Is Patentable Over Nalle

New claim 74 is patentable over Nalle because (a) Nalle fails to disclose or suggest all the elements of claim 74, and (b) one of ordinary skill in the art would not be motivated to modify Nalle to include the claimed features. For example, assuming for the sake of argument that Nalle's ornamental sheet and paper disk correspond to the background material of claim 74, Nalle fails to disclose, *inter alia*, "the background material being configured so that at least approximately the entire first surface of the background material in the base portion and in the first region of the wall portion is visible through the second region of the wall portion from the exterior region," as recited by claim 74. To the contrary, Nalle's ornamental sheet extends from the base to the flared edge completely around the side wall of the tumbler, and accordingly, obstructs the view through the side wall of most, if not all, of the paper disk in the base. Therefore, Nalle does not disclose each and every element of claim 74.

One of ordinary skill in the art would not be motivated to modify Nalle's tumbler to include the features of claim 74 because such a combination would destroy one purpose of Nalle's invention. Nalle states, "[o]ne of the objects of my invention is to provide a tumbler whose walls are heat-insulating." (Nalle, col. 1, ll. 16-17.) Nalle explains that the "heat-insulating effect may be enhanced by the interposition of [the ornamental] sheet between shells, since this sheet may be of such a nature as to

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provide a heat-barrier." (Nalle, col. 2, ll. 58-60.) Accordingly, Nalle's tumbler includes an ornamental sheet that extends from the flared edge to the base all the way around the tumbler to thermally insulate the drink in the tumbler, and thereby accomplish one purpose of Nalle's invention. If one were to modify Nalle's tumbler to remove a portion of the ornamental sheet in the side wall, the thermal insulating characteristics of that portion of the side wall would be impaired and one purpose of Nalle's invention would be thwarted. Therefore, one of ordinary skill in the art would not be motivated to modify Nalle's tumbler to arrive at the features of claim 74. Thus, claim 74 is patentable over Nalle because (a) Nalle fails to disclose each and every element of claim 74 and (b) one of ordinary skill in the art would not be motivated to modify Nalle's tumbler to include every feature of claim 74.

4. New Claim 75 Is Directed to a Vessel Including a Background Material Positioned in a First Region of a Wall Portion and Absent from a Second Region of the Wall Portion

New claim 75 is directed to a vessel for observing a chemical substance. The vessel includes a base portion, an optically transmissive wall portion projecting away from the base portion, and a background material. The base portion has an outer surface and an inner surface. The optically transmissive wall portion has an inner surface, an outer surface, a first region, and a second region opposite the first region. The outer surfaces of the base and wall portions define an exterior region, and the inner surfaces of the base and wall portions define an interior region. The interior region is configured to contain the chemical substance and has an opening configured to removably receive the chemical substance. The background material has a first surface facing toward the interior region and a second surface facing away from the first surface. The background material is positioned between the inner and outer surfaces of the base portion and the wall portion. The background material is positioned in the first region of the wall portion at a first distance spaced apart from the base portion. The background material is absent from the second region of the wall portion at a second distance spaced apart from the base portion. The second distance is at least approximately equal to the first distance. Accordingly, the background

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material allows a practitioner to view the chemical substance against the background material without having to separately support and move an adjacent piece of background material, such as a sheet of paper or a paper towel.

5. New Claims 75-83 Are Patentable Over Nalle

New claim 75 is patentable over Nalle because (a) Nalle fails to disclose or suggest all the elements of claim 75, and (b) one of ordinary skill in the art would not be motivated to modify Nalle to include the claimed features. For example, assuming for the sake of argument that Nalle's ornamental sheet and paper disk correspond to the background material of claim 75, Nalle fails to disclose, *inter alia*, "the background material being positioned in the first region at a first distance spaced apart from the base portion and being absent from the second region at a second distance spaced apart from the base portion, the second distance being at least approximately equal to the first distance," as recited by claim 75. To the contrary, Nalle's ornamental sheet extends uniformly from the base to the flared edge all the way around the side wall of the tumbler. Therefore, Nalle does not disclose each and every element of claim 75. Furthermore, one of ordinary skill in the art would not be motivated to modify Nalle's tumbler to include the features of claim 75 because such a combination would destroy one purpose of Nalle's invention, as described above with reference to claim 74. Accordingly, claim 75 is patentable over Nalle.

Claims 76-83 depend from claim 75. Accordingly, claims 76-83 are patentable over Nalle for the reasons discussed above with reference to claim 75 and for the additional features of these claims.

E. Conclusion

In light of the foregoing amendments and remarks, all of the pending claims are in condition for allowance. Applicant, therefore, requests reconsideration of the application and an allowance of all pending claims. If the Examiner wishes to discuss the above-noted distinctions between the claims and the cited references or any other distinctions, the Examiner is encouraged to contact David Dutcher by telephone (206-

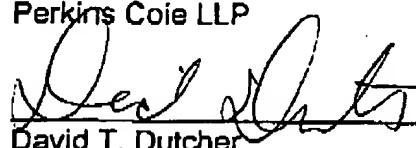
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359-6465). Additionally, if the Examiner notices any informalities in the claims, he is also encouraged to contact David Dutcher to expediently correct any such informalities.

Respectfully submitted,

Perkins Coie LLP

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